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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,362	01/14/2002	Robert A. Lindner	1021-01	5588

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EXAMINER

MULCAHY, PETER D

ART UNIT PAPER NUMBER

1713

DATE MAILED: 10/08/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/047,362

Applicant(s)

LINDNER, ROBERT A.

Examiner

Peter D. Mulcahy

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 January 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. § 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-15 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hiyama et al., U.S. Patent 3,793,274.

Hiyama discloses in Table 1, Example 3, a composition including PVC, butylstearate (component B2), and a polymerized fatty acid which contains a component having 54 carbon atoms. See column 2 lines 28-36. The ratios of the ester to PVC and acid to ester are within the claimed ranges. It should be noted

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that claim 4 does not require that the recited material be present, as such the disclosure of butylstearate as B2 meets this claim as well.

It is herein maintained that this reference discloses all the limitations of the claim except for the property. The Examiner cannot determine whether or not the reference inherently possesses properties which anticipate or render obvious the claimed invention but herein has a basis for shifting the burden of proof to applicants as in In re Fitzgerald et al. 619 F. 2d 67, 205 USPQ 594, 596, (CCPA 1980).

Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Yoshida et al., U.S. Patent 4,670,490.

Yoshida discloses making molding materials or shaped articles from a composition based on PVC, C<sub>1</sub>-C<sub>35</sub> mono or polyhydric alcohol esters of C<sub>2</sub>-C<sub>35</sub> mono or polybasic carboxylic acids such as dicarboxylic aromatic acids, see specifically column 6 line 15 - column 7 line 9. Acrylic or methacrylic acid resins which can include a comonomer component having carboxylic acid groups is shown at column 7 line 23 - column 8 line 41. This component is further described as having a molecular weight of about 1500 to 50,000. See column 7 lines 10-22. The ratio of ester to PVC and acid to ester can be within the ranges as claimed. See column 6 lines 15-19 and column 7 lines 10-22. The

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reference fails to anticipate the claimed invention because it does not specifically disclose using in combination with the recited mono or polyhydric alcohol esters of mono or polybasic carboxylic acids the acrylic or methacrylic acid resin having the carboxylic acid groups. However because the reference teaches that the acid group containing resin is an optional additive, it would have been obvious to one of ordinary skill in the art to use it in the composition. It is further maintained that this reference would possess properties which either render obvious or anticipate the properties as instantly claimed given the fact that the same composition is disclosed.

Claims 1-15 are rejected under 35 U.S.C. § 103(a) as being unpatentable over any one of Brecker et al., U.S. Patent 4,447,569, Anderson et al., U.S. Patent 3,905,927 or Lamb, U.S. Patent 4,133,794 each taken alone and further in view of Hiyama et al., U.S. Patent 3,793,274.

Brecker a column 4 line 47 - column 5 line 33, Anderson at column 2 lines 11-29 and column 2 line 56 - column 3 line 10 and Lamb at column 2 line 3 - column 3 line 10 disclose the combination of PVC and an ester as recited in applicants' claims. The references do not disclose including in the composition an organic acid having at least 40 carbon atoms. However, because each reference teaches that a PVC lubricant can be included in

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the composition, specifically at Brecker column 6 line 65 - column 7 line 3, Anderson at column 2 line 65 - column 3 line 10 and Lamb at column 4 lines 18-22, it would have been obvious to one of ordinary skill in the art to include in each composition a lubricant in the art to be effective in a PVC composition. Such a lubricant is an organic acid having over 40 carbon atoms as disclosed by Hiyama at column 2 lines 28-36. It is further maintained that the instantly claimed properties would be either anticipated or rendered prima facie obvious by the compositions which are rendered prima facie obvious from the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter D. Mulcahy, whose telephone number is (703) 308-2449. The examiner can normally be reached on Tuesday through Friday from 7:30 A.M. to 6:00 P.M.

The fax telephone number for this group is (703) 872-9306.

Any inquiry of general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.

P. Mulcahy:cdc  
September 30, 2003

  
PETER D. MULCAHY  
PRIMARY EXAMINER